

REMARKS

Claims 1-18 are pending in this application. By this Amendment, the drawings and claim 1 are amended. The claims are amended only to provide clarification of the subject matter Applicants regard as the invention and do not narrow the scope of the claims or present new subject matter. As such, the amendments to claim 1 only make explicit that which was implicit in the original claim.

Entry of the amendments is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because e.g. they are made in response to arguments raised in the final rejection.

Entry of the amendments is thus respectfully requested.

I. Interview

Applicants appreciate the courtesies extended to Applicants' representative during the personal interview and the subsequent telephone communication, each conducted on December 22, 2003. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

II. Drawings

The drawings are objected to under 37 C.F.R. §1.84(p)(5) as containing a reference number (24a) that is not described in the specification. Fig. 1 is amended in reply to the objection. Accordingly, Applicants respectfully request the objection to the drawings be withdrawn.

III. Claim Rejections under 35 U.S.C. §112

Claims 10, 12, 14 and 16 are rejected under 35 U.S.C. §112, first paragraph. The rejection is respectfully traversed.

Regarding claim 10, as discussed during the personal interview, Applicants submit that the features recited in claim 10 are sufficiently described in the specification to enable one skilled in the art to make and/or use the invention. For example, the Office Action alleges that "it is unclear as to how fastening means/bolts project radially outward from an inscribed circle of said bolt heads." However, claim 10 recites that said projecting members project radially outward from an inscribed circle of said bolt heads and not fastening means/bolts as stated in the rejection. Support for the subject matter of claim 10 may be seen in Fig. 4 as well as page 5, lines 2-22 of the specification.

Regarding the rejection of claims 12, 14 and 16, "said fastening means" includes the fixing portions 36 and 37 (see Fig. 1 showing the fixing portion 36 on the center casing 7 and the fixing portion 37 on the end frame 6). Thus, the "fastening means" projects radially outward from an inscribed circle of the bolt heads, as recited in claim 12.

IV. Claim Rejections under 35 U.S.C. §102

Claims 1-3 and 8-18 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,847,471 to Morishita et al. (Morishita). The rejection is respectfully traversed.

As discussed during the personal interview, Applicants assert that Morishita does not disclose each and every feature recited in amended claim 1. For example, Morishita does not disclose a starter for an internal combustion engine . . . comprising *inter alia* a front housing for supporting the pinion drive shaft, the front housing having a bearing for supporting the pinion drive shaft at one end of the shaft and an integrally formed and radially-outwardly extending flange for providing a plurality of fastening holes disposed at a circumference

having a second diameter through which a plurality of fastening bolts is fixed to a portion of the internal combustion engine.

Rather, the housing (21) of Morishita has no such flange, nor does the housing (21) have a plurality of fastening holes that allow the fixing to the internal combustion engine. Rather, Morishita has holes (21a) to receive screws (33) by which a separate flange (32) is attached to the front housing. It is the separate flange (32) of Morishita that has a plurality of engine mounting holes (32a) for fastening to an internal combustion engine. Thus, Morishita does not disclose a front housing (21) having an integrally formed and radially outwardly extending flange for providing a plurality of fastening holes disposed at a circumference having a second diameter through which a plurality of fastening bolts is fixed to a portion of the internal combustion engine. Therefore, Morishita does not disclose each and every feature recited in the rejected claims. Accordingly, Applicant respectfully request the rejections of claims 1-3 and 8-18 under 35 U.S.C. §102(b) be withdrawn.

V. Claim Rejections under 35 U.S.C. §103(a)

Claim 4 is rejected under 35 U.S.C. §103(a) is unpatentable over Morishita and claims 5-7 are rejected under 35 U.S.C. §103(a) as unpatentable over Morishita in view of U.S. Patent 4,325,265 to Wakatsuki et al. (Wakatsuki). The rejections are respectfully traversed.

Applicants assert that claims 4-7 are allowable for at least their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein.

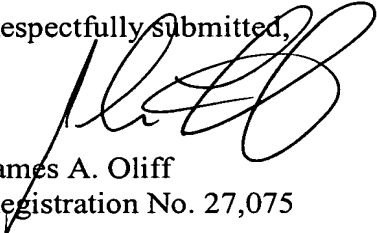
VI. Conclusion

Applicants appreciate Examiner Van Pelt's telephone communication, following the personal interview, agreeing to withdraw the Final Rejection, in light of the personal interview. In view of the foregoing, it is respectfully submitted that this application is in

condition for allowance. Favorable reconsideration and prompt allowance of claims 1-18 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:JWF/ldg

Attachment:
Replacement Sheet

Date: December 22, 2003

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